



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,500	06/07/2000	Yechiam Yemini	19240-232	8506
28089	7590	01/13/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 399 PARK AVENUE NEW YORK, NY 10022			LAFORGIA, CHRISTIAN A	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,500

Applicant(s)

YEMINI ET AL.

Examiner

Christian La Forgia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/23/04; 10/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2131

DETAILED ACTION

1. The amendment filed on 21 June 2004 is noted and made of record.
2. Claims 1 and 2 have been presented for examination.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on 23 June 2004 and 28 October 2004 were considered by the examiner.

Drawings

4. The drawings were received on 21 June 2004. These drawings are acceptable.

Response to Arguments

5. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.
6. See further rejections that follow.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner would like to point out that where applicant acts as his or her own lexicographer to specifically define a term of a claim the written description must clearly define the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so define that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir.

Art Unit: 2131

1999). In addition, the Applicant fails to meet the requirements of defining a term as set forth in the MPEP § 2106. In order to define/redefine a term, the Applicant must do so “with reasonable clarity, deliberateness, and precision” and must “set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change” in meaning. The phrase “electronic security value units” in claims 1 and 2 renders those claims indefinite because the claim language does not clearly define the term. The Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,640,304 to Ginter et al., hereinafter Ginter.

11. As per claim 1, Ginter teaches a method for monitoring accesses to a resource in an electronic system, wherein access to the resource is based on payments in electronic security value units, said method comprising the steps of:

detecting patterns of payments for said resource in electronic security value units (column 58; lines 24-59, i.e. “In this simple example, the “event process” 402 may request metering,

Art Unit: 2131

billing and/or budgeting processes the first time the user asks to open the protected novel (so the purchase price can be charged to the user), and treat all later requests to open the same novel as “insignificant events.” Other content (for example, searching an electronic phone directory) may require the user to pay a fee for each access.”); and,

comparing said patterns of payments to predetermined patterns of payment (column, lines 11-23, i.e. “Such checks, performed in clearinghouses 116, can detect patterns of use that may or do indicate fraud (e.g. excessive acquisition of protected content without any corresponding payment)”).

11. Regarding claim 2, Ginter teaches the step of:

determining a difference in the compared patterns of payments to said predetermined patterns of payments (column, lines 11-23, i.e. “Such checks, performed in clearinghouses 116, can detect patterns of use that may or do indicate fraud (e.g. excessive acquisition of protected content without any corresponding payment)”),

wherein when said difference is greater than a predetermined difference, an attack is indicated (column, lines 11-23, i.e. “Such checks, performed in clearinghouses 116, can detect patterns of use that may or do indicate fraud (e.g. excessive acquisition of protected content without any corresponding payment)”).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2131

14. The following patents are cited to further show the state of the art with respect to pay-per services with detecting payment patterns, such as:

United States Patent No. 6,594,481 to Johnson et al., which is cited to show detecting potentially fraudulent telecommunications.


United States Patent No. 6,704,563 to Senn et al., which is cited to show pre-rating costs for a communication event.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian LaForgia
Patent Examiner
Art Unit 2131


EMMANUEL L. MOISE
PATENT EXAMINER

clf